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09/745,669	12/21/2000	Brian M. Siegel	50N3787	5754
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MAYER & WILLIAMS PC 251 NORTH AVENUE WEST 2ND FLOOR WESTFIELD, NJ 07090			EXAMINER ZURITA, JAMES H	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/745,669
Filing Date: December 21, 2000
Appellant(s): SIEGEL ET AL.

MAILED

JAN 16 2008

GROUP 3600

KARIN L. WILLIAMS
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the appeal brief filed 4 October 2007 appealing from the
Office action mailed 10 January 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6652455	Kocher	11-2003
6448979	Schena	09-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 5- 7, 28 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schena (US 6,448,979 B1) in view of Kocher (US 6,652,455 B1).

Regarding claim 1, 7 and 28, Schena teaches a method for retrieving information related to a consumer product comprising the steps of:
integrating a bar code scanner and a removable memory into a consumer good, wherein said consumer good comprises a non-electronic device;
scanning a bar code of a selected consumer product using the integrated scanner and
storing the scanned bar code;
transferring the scanned bar code to a computer network; and
accessing a web site on the computer network based on the scanned bar code, wherein said web site includes information related to the selected consumer product (see at least Col 3, lines 42 - 63, Col 4, lines 32 - 37, Col 5, lines 34 - 39 and Col 6, lines 27 - 36).

Schena discloses storing of the scanned bar code/data in an enhanced device such as key chain or a smart card, in which the scanner is incorporated/ integrated. Schena also discloses the use of PC cards. Schena **does not** specifically disclose and teach a removable memory in pens, for example.

On the other hand and in the same area of storing data in a scanning device, Kocher teaches storing the data in a removable memory (Col 5, lines 27 -30).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the apparatus and method of Schena with the apparatus and method of Kocher to meet the claim limitations of claim 28. Schena discloses a method and apparatus for retrieving information related to a consumer product comprising the steps of: integrating a bar code scanner and a removable memory into a consumer good, wherein said consumer good comprises a non-electronic device; scanning a bar code of a selected consumer product using the integrated scanner and storing the scanned bar code; transferring the scanned bar code to a computer network; and accessing a web site

one the computer network based on the scanned bar code, wherein said web site includes information related to the selected consumer product (see at least Col 3, lines 42 - 63, Col 4, lines 32 - 37, Col 5, lines 34 - 39 and Col 6, lines 27 - 36). In turn, Kocher discloses a method and apparatus for storing the data in a removable memory of a scanner (Col 5, lines 27 -30). Therefore, one of ordinary skill in the art would have been motivated to extend the method and apparatus of Schena with a method and apparatus for apparatus for storing the data in a removable memory of a scanner - in order to provide an old and well known option.

Regarding claim 5 Schena teaches an apparatus, wherein said non- electronic device comprises one of the following: an article of clothing, a pen and a pocketbook (Col 3, line 53).

Regarding claim 6 Kocher teaches an apparatus, wherein said removable memory medium comprises one of the following: a magnetic disc, flash memory, a smart card, a memory stick, a diskette, a CD-ROM, a disk drive, a random access memory chip, and an optical storage device (Col 5, lines 27 - 30). Please note that Kocher **does not** specifically disclose a smart card. However, Schena does disclose a smart card. In that regard, it would have been obvious to one of ordinary skill in the art at the time of the invention to have extended the removable memory disclosed by Kocher, with removable memory such as a smart card.

Regarding claim 31, Schena teaches a method, further comprising converting a scanned bar code to a uniform resource locator of a web site (Col 4, lines 32 - 37).

Regarding claim 32 the recitation "further comprising converting a scanned bar code and a global position to a uniform resource locator (URL) of a web site), such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other "converting" already disclosed by Schena.

(10) Response to Argument

The Examiner notes that appellant's "...consumer good ...non-electronic device..." "... a non-Internet-ready portable consumer good..." and, in claim 1 "...portable consumer good that lacks the capacity for data transmission..." all refer to non-electronic, portable consumer goods such as pens, clothing (e.g., gloves), pocketbooks, and so forth (paragraph 0035).

Appellant's pre-KSR brief argues that there is no teaching suggestion or motivation to combine, Schena and Kocher. Appellant's claimed improvements are no more than the predictable use of prior art elements according to their established functions; no further analysis is required by the Examiner. KSR, 127 S.Ct. at 1740, 82

USPQ2d at 1396. However, to facilitate review, the Examiner's explicit analysis is repeated here.

Appellant argues,

... without the teachings provided by Appellant's disclosure ... "road map" to piece together the teachings of the prior art...even if one used impermissible hindsight and combined the teachings of the references, the present invention would **not** be achieved.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant also argues,

...Kocher does **not** teach or suggest storing scanned information in a removable memory medium, *wherein the removable memory medium may be removed therefrom and inserted into an internet-ready device*.

Kocher, relied upon for teaching a removable memory device, is directed to a device specifically designed "for scanning"- **unlike** Applicants' claimed invention that recites a portable consumer good that lacks the capacity for data transmission [Examiner noted: a piece of clothing] and comprises a non-electronic device -- and that has a scanning a storage device incorporated therein.

In response, Schena discloses the use of PC card devices, as in col. 3, lines 48-57. PC cards are credit-card sized, removable module that contains memory. Schena's smart card (Col. 3, lines 50-55) is consistent with applicant's use of smart cards

(paragraph 0002). Kocher is used to illustrate a specific example of appellant's invention, such as a pen.

Appellant argues that Schena does **not** teach or suggest, nor would one of ordinary skill in the art be motivated (in light of the teachings of Kocher at least), to modify Schena to include a removable memory device.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

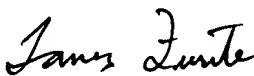
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

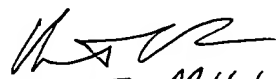
James Zurita
Primary Examiner


JAMES ZURITA
PRIMARY EXAMINER

Conferees:

James Zurita *JZ*
Primary Examiner


Jeffrey A. Smith
Supervisory Patent Examiner


VINCENT MILLIN
Appeals Conference Specialist